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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 40399/177/NIHD

In re patent application of

Jerry M. Keith

Serial No. 07/542,149

Group Art Unit: 1814

Filed: June 22, 1990

Examiner: G. Bugalsky

For: PERTUSSIS TOXIN GENE: CLONING
AND EXPRESSION

19/Conversion
JP.
12-15-92
(115)
DEC 14 1992

GROUP 180

PETITION FOR CORRECTION OF INVENTORSHIP
UNDER 37 CFR §1.48(a)

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Pursuant to 37 CFR §1.48(a), applicants hereby petition to amend the inventorship of the above-identified application ("the present application") to delete Jerry M. Keith as the sole inventor and insert Witold Cieplak as the sole inventor.

Filed concurrently with this petition are:

- (1) a verified statement of facts by Jerry M. Keith, which attests (i) that the incorrect inventorship arose through error without deceptive intention, and which also identifies (ii) when the error was discovered and (iii) how it occurred;
- (2) an declaration under 37 CFR §1.63 which executed by Witold Cieplak;
- (3) the written consent of the assignee, the U.S. Department of Health and Human Services; and
- (4) payment for the petition fee prescribed by applicable PTO rules.

Applicants believe that the appended payment to be sufficient. The Commissioner is authorized, however, to

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The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 18-0741.

charge any additional amount needed for this petition to PTO account No. 19-0741.

STATEMENT OF FACTS IN SUPPORT OF THIS PETITION

An error in the inventorship of this application was discovered during a recent investigation by Foley & Lardner, conducted on behalf of NIH in anticipation of a possible interference. See paper No. 7, entitled AMENDMENT UNDER 37 CFR §1.111 AND REQUEST FOR INTERFERENCE UNDER 37 CFR §§1.604 AND 1.607, which applicants filed on October 5, 1992.

The investigation revealed that Dr. Cieplak, who had worked closely with the presently-named inventor, Dr. Keith, in research pertaining to *Bordetella pertussis* toxin, in fact was responsible for conception of the subject matter claimed in the present application. In this regard, Dr. Keith attests that he had worked previously on the cloning of the *pertussis* toxin gene, which is the subject of U.S. patent No. 4,883,761. The *pertussis* toxin project, which continued under Dr. Keith's supervision, came to involve a number of individuals, including Dr. Cieplak, and led eventually to the preparation of an application directed to DNA coding for a mutant *pertussis* toxin ("the claimed invention").

Dr. Keith further attests that he consulted with responsible counsel regarding the proper constituency of an inventive entity for the new application. In particular, Dr. Keith was advised that he qualified as the sole inventor of the aforementioned DNA. No formal inquiry of Dr. Keith's records were made in this context, however, until present counsel undertook the investigation mentioned above. In late October, this investigation prompted the conclusion that Dr. Cieplak and not Dr. Keith was the sole inventor of the claimed invention.

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In view of the foregoing, it is requested that the inventorship of this application be amended to name Dr. Cieplak as the sole inventor.

Respectfully submitted,

December 2, 1992
Date

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